Appendix A

Decision—First Trial

UNITED STATES DISTRICT COURT

D. DELAWARE

Civ. A. No. 2271.

Dec. 5, 1962.

STEEL, District Judge.

S. W. Farber, Inc., the plaintiff, sued Texas Instruments, Inc., the defendant, for infringement of U. S. Letters Patent No. 2,926,230 which was issued to plaintiff as assignee of Hoyt K. Foster, the patent applicant. The subject matter of the patent is a detachable temperature regulating connector for an electrically heated device such as a cooking utensil. The combination patent is for the regulating connector itself; the device with which the connector is used is not claimed as a part of the patented combination. The parties have stipulated that a decision with respect to Claim 1 will be dispositive of all other claims.[1]

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1. Claim 1 reads:

"A detachable temperature regulating connector for an electrically heated device comprising in combination a housing, a pair of terminals in said housing for frictional engagement with co-operating terminals on said device, a bracket within said housing, an elongated hollow member carried by said bracket and extending from said housing, said member being formed of a material having a given temperature coefficient of expansion, a pair of electrical contact members affixed to said bracket and connected with at least one of said pair of terminals, a flexible member fixed at one end relative to said bracket and elongated member and extending in a direction generally parallel to said elongated member, the free end of said flexible member being coupled to at least one of said contacts to open and close the contacts when deflected, and a tension member formed of a material having a different temperature coefficient of expansion connecting the distal end of said elongated member with said flexible member at a point between the ends thereof whereby variations in temperature will deflect said flexible member to open and close said contacts."

The plaintiff is incorporated in New York, the defendant in Delaware. Jurisdiction exists under 28 U. S. C. §1338(a).

By virtue of Pretrial Order dated November 27, 1961, the issue before the Court is limited to whether Foster was the sole inventor or whether Burch, or two of defendant's employees, Moorhead or Butts, were joint inventors with Foster.[2] At this juncture it is assumed that the patent is in all other respects valid, since all other defenses have been reserved for later determination, if the defense of joint inventorship should fail.

The plaintiff is engaged in the manufacture and sale of cooking utensils of various kinds. The defendant manufactures and sells thermostats through the Spencer Thermostat Division of its subsidiary Metals & Controls. Neither defendant nor its subsidiary manufactures or sells cooking ware.

Sometime in 1954, Foster, plaintiff's chief engineer, recognized the desirability of developing an electrically heated thermostatically controlled frying pan which could be completely immersed in water for washing. This was not possible with frying pans then on the market because the thermostats were in the handles and could not be detached when the pans were washed. Foster conceived the general idea of solving the problem by putting a probe type of thermostat in a detachable electric plug. Under this general conception a portion of the probe would extend from the plug through a hole midway between the electrical contacts of the plug so as to engage the bottom of the pan and sense its temperature. It was Foster's idea that the action of the thermostat in opening and

2. Defendant's alternative contention, asserted for the first time after trial, that Milton Farber, vice-president of plaintiff, was a joint inventor with plaintiff, is beyond the issue defined by the Pretrial Order.

closing the electrical circuit would keep the pan at predetermined temperature.

Foster's conception did not embrace the use of any particular kind of probe thermostat, although there were several on the market. When the "bulb and bellows" probe type of thermostat which he tried appeared to be unsuitable, he began to look for "a cartridge" type; that is, one cylindrical in shape, less than ½ inch in diameter, and not over 3-4 inches long, for use as a thermal unit in the plug.

On March 31, 1954, Lyndon W. Burch had filed a patent application for a cartridge type thermostat which embodied the "rod and tube" principle.[3] The patent application did not show any specific use to which the thermostat might be put. It simply disclosed a unit which would move in a certain way in response to temperature variation. This application eventuated in Patent No. 2,793,270 which issued to Burch on May 21, 1957.

On October 12, 1954, Burch, having heard from a third party of Foster's desire to obtain a cartridge type thermostat, came to see Foster. Burch showed Foster several models which he had made, and demonstrated them. It was the first time that Foster had seen a cartridge type of thermostat that could be adapted to a removable plug in a cooking utensil, and he thought that it might be what he was looking for. Foster asked Burch about the availability of his thermostat. Burch said that he had already been in contact with Metals & Controls and that it had an option on the thermostat. Foster indicated that he was dubious about utilizing Metals & Controls to make the thermostat because in the past when plaintiff had attempted to work with Metals & Controls, plaintiff had not received a "good reception".

3. The manner in which the rod and tube functioned is not particularly relevant.

On October 13, 1954 Foster wrote a letter to a law firm, Morgan, Finnegan & Durham, enclosing a "sketch and some explanation" of an electric cooking utensil with removable heat control plug dated October 12, 1954. The letter and enclosure set forth the general idea of a detachable plug thermostat for an electric cooking utensil. The thermostat there disclosed was representative only, in a general way, of several types of thermostats that might be used.[4]

On the same day, Foster built what is sometimes referred to as a mock-up or "bread board" model, of an electrical plug which embodied the Burch thermostat. This was simply an experimental design to find out how good the heat control would be for frying pan usage.

On October 14, Foster tested the model by searing and cooking a pot roast. To bring the heat up to the desired level, it was necessary for Foster to make periodic adjustments of the thermal unit. Foster said that apart from enabling him to test how good heat control the Burch thermostat would give, it was "far from being a satisfactory model. It wasn't what you would consider a commercial model".

At about this same time, Burch saw Ottmar, the Vice President and general manager of Spencer Thermostat

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4. On November 30, 1954, Foster filed a patent application, Serial No. 471,949, upon the basis of the disclosures in his letter to his patent attorneys. That application embodied none of the details of the patent in suit.

On September 22, 1955, Foster filed a second patent application, Serial No. 535,797.

On February 10, 1959, Foster filed a third patent application, Serial No. 792,387. This had been divided out of Foster's second application, Serial No. 535,797. It eventuated in the patent in suit, No. 2,926,230 which issued on February 23, 1960.

Foster's first application and the counts of his second application remaining after the filing of the divisional application, are still in the Patent Office.

Division of Metals & Controls, and told him of his meeting with Foster. Burch asked Ottmar whether the defendant would be interested in manufacturing a thermostat for plaintiff. Ottmar was interested and authorized his people to do whatever development work on the thermostat as was necessary. Prior to this, Burch had orally agreed with Ottmar that defendant could have a license under the Burch patent.

Between October 14 and October 22, Farber and Foster discussed the refinements necessary to commercialize the thermostatic control plug as a detachable temperature regulator for a cooking utensil. They recognized that it was wrong to depend on the plastic plug to house the thermostat and to hold it in place, and that a rigid support was needed to keep the probe in alignment with the contacts which opened and closed the electrical circuit and with the adjusting screw. A rigid unitary construction was necessary not only for accuracy of calibration, but to enable the thermal unit to have a small amount of wiggle or play, within the plug. Without the wiggle, it was not possible for the thermal unit to accommodate itself to the "warping" movement of the bottom of the pan which occurred when the pan was heated due to its bi-metallic construction. Furthermore, since plaintiff contemplated that Leviton Manufacturing Company would supply the plug cord and electrical connector and assemble the thermostatic unit in the plug, Farber and Foster knew that unless the sensing tube and the electrical contacts were rigidly held in a fixed position with relationship to each other, shipment of the thermal unit would entail movement between the parts and would not be practical.

On October 22, 1954, Burch brought Lowell Comee from Metals & Controls to the Farber office to meet Farber and Foster. Foster showed Comee and Burch the mock-up model which he had made on October 13 and stated that he

was going to use it as a plug in a device for controlling the heat of a frying pan. Burch asked if he could take the unit back to Metals & Controls so that it could evaluate the unit and see what could be done toward producing one which was commercially practical. With Foster's permission, Comee and Burch took with them the "bread board" model which Foster had built on October 13. Testimony as to other aspects of the meeting is in dispute and will be discussed later.

On November 11, a meeting was held at the Farber plant between Comee, Ottmar, Farber and Foster. Ottmar was a vice president and general manager of Metals & Controls and knew that the plaintiff felt its past experience with the defendant had not been good. Consequently, he devoted himself to attempting to convince Farber that the defendant was the right concern to manufacture the thermal unit for plaintiff. Ottmar said that defendant was building a sample of the thermostat for testing. He and Farber also discussed various business aspects of the matter, costs and so on. Technical discussions took place between Foster and Comee which are discussed in a later portion of the opinion.

On November 17, 1954, Comee and Moorhead, assistant chief engineer of Spencer Thermostat Division, met with Farber and Burch at plaintiff's plant and showed them a thermostat that Metals & Controls had made to see if it would work as plaintiff required. It was shown to them for their criticisms and approval. This model, constructed by Moorhead, was the first physical embodiment of the thermostat which included a bracket interconnecting the probe and electrical contacts so as to create a unitary assembly.

Following this meeting, Butts, another employee of Metals & Controls, made a minor change in the model which Comee and Moorhead had exhibited to Farber and

Foster, consisting of a reversal of the position of the contacts.

On December 2, 1954, Moorhead, Butts and Comee visited plaintiff's plant and showed Farber and Foster a thermostat which incorporated Butts' modification. Defendant had built this thermostat into a cord plug which plaintiff had furnished to it. The thermostat was substantially the bread board model which Foster had given to Burch on October 22, except that, unlike the bread board model, it contained a bracket which interconnected the probe thermal element with the switch contacts and adjusting screw and resulted in a unitary assembly of the entire thermostat. At this conference test runs were made with a frying pan which looked very encouraging.

The design of the unit which defendant submitted to plaintiff on December 2, 1954 was substantially the eventual commercial version of the detachable control plug. Claim 1 of the patent in suit reads on this structure.

On February 10, 1955 plaintiff and defendant entered into a contract under which plaintiff agreed to purchase 100,000 thermostats from defendant during the year 1955 and 150,000 thermostats during the year 1956 on the condition that defendant would manufacture exclusively for plaintiff during these years.

Thereafter thermostats manufactured by defendant were shipped to Leviton Manufacturing Company which supplied complete cord sets and assembled the thermostatic units into the plugs. Leviton then shipped these units to plaintiff which added the knob and decal to the plug. Plaintiff did the final testing. Manufacturing defects began to appear in the thermal unit, and plaintiff finally decided to stop selling thermostats manufactured by defendant and to adopt a substitute made by another manufacturer. At the time, plaintiff had not purchased from defendant either in 1955 or 1956 all of the thermostats which it had agreed to take.

Sometime in 1956, Fred Stern, an employee of the defendant, asked Farber what the plaintiff would do if defendant began to manufacture plug and cord sets like plaintiff's. Farber replied that plaintiff would sue the defendant. When defendant did so the present suit was brought.

A presumption of validity of the Foster patent arose upon its issuance. 35 U. S. C. §282. This presumption, however, is a weak one since the question of joint inventorship was not before the Patent Office. Cf. Dole Refrigerating Co. v. Americo Contact Plate Freezers, 265 F. 2d 627, 629 (3 Cir. 1959).

35 U. S. C. §116 makes it obligatory for a patent to be applied for jointly where the invention claimed is made by one or more persons jointly. If a patent issues upon the application of a person who claims to be the sole inventor and it later appears that the subject matter of the patent was invented jointly by two or more persons, the patent is invalid. Larson v. Crowther, 26 F. 2d 780, 789 (8 Cir. 1928), cert. den. 278 U. S. 648, 49 S. Ct. 83, 73 L. Ed. 560 (1928); Worden v. Fisher, 11 F. 505, 506 (C. C. E. D. Mich. 1882); Fox v. Spiegel, 50 F. 2d 195 (D. Conn. 1931). It is this principle which defendant invokes to invalidate the patent in suit.

Defendant's contention that Burch was a joint inventor is rejected. It is true that, as Farber testified, the Burch thermostat was the heart of Foster's patent. Nevertheless, prior to October 12, 1954 the Burch thermostat had been freely demonstrated and Burch had sold 50 of the units for use on aircraft ground heaters. Burch's disclosure of the thermostat to Foster was not confidential or secret. It was clearly in the prior art when Burch revealed it to Foster.

Furthermore, when Burch visited Foster on October 12, 1954, he did not know why Foster was interested

in his thermostat. During the meeting Burch suggested no use for it, although at the meeting he learned that Foster's interest was in finding a thermostat to use in an electrical plug with a frying pan. The problem which Foster was seeking to solve was one which Foster—not Burch—had recognized. The solution was sought by Foster—not Burch. Insofar as the Burch thermostat contributed to the solution, it was Foster—not Burch—who recognized its utility, in combination with other elements, to solve the problem upon which he alone was working when the Burch thermostat came to his attention. Prior to the time when Foster determined that the Burch thermostat might be useful, there had been no collaboration between Burch and him, nor had they been working together toward a common end. These are essential to joint inventorship. Pointer v. Six Wheel Corp., 177 F. 2d 153, 157 (9 Cir. 1949); McKinnon Chain Co. v. American Chain Co., 268 F. 353, 360 (3 Cir. 1920).

Furthermore, the fact that Burch was the inventor of the thermostat did not make him a joint inventor of the combination in which the thermostat was but a part. A patent consisting of a combination of elements is, in legal contemplation, a separate and distinct entity from any of its component parts. A person who is the sole inventor of a combination, wholly apart from whether he is an inventor of an element thereof, is entitled to a patent on the combination. Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Co., 340 U. S. 147, 150-153, 71 S. Ct. 127, 95 L. Ed. 162 (1950); Helms Products, Inc. v. Lake Shore Mfg. Co., 227 F. 2d 677, 681 (7 Cir. 1955); Coleman v. Holly Mfg. Co., 233 F. 2d 71, 79 (9 Cir. 1956), cert. den. 352 U. S. 952, 77 S. Ct. 326, 1 L. Ed. 2d 243 (1956). A combination patent may be valid even if every element of the combination is old provided that there is invention in the combination as an entirety. General Motors Corp. v.

Swan Carburetor Co., 88 F. 2d 876 (6 Cir. 1937), cert. den. 302 U. S. 691, 58 S. Ct. 49, 82 L. Ed. 534 (1937), reh. den. 302 U. S. 777, 58 S. Ct. 137, 82 L. Ed. 601 (1937).

One further aspect of the matter must be considered. It is admitted by plaintiff that at the time when Foster built the bread board model on October 13 he had not conceived of the invention disclosed by Claim 1[5] and that Foster's cooking experiment on October 14 was not a reduction to practice of the invention.[6] The bracket to which the probe, electrical contacts and adjusting screw are affixed in Claim 1 were missing from the bread board model and had not been conceived of when it was built.[7] The omission of the bracket from the bread board model is the only difference between it and Claim 1.

The bracket was essential to satisfactory operation of the thermostat and is a material element in Claim 1. Defendant argues that the utilization of the bracket was conceived of by either Moorhead or Butts sometime after Burch and Comee met with Foster and Farber on October 22, and that the model of the thermostat which they built and submitted to plaintiff on December 2 (when tested on or about that date) was the first reduction to practice of the invention disclosed in Claim 1. This conception and reduction to practice by Moorhead or Butts, defendant argues, made them joint inventors with Foster.[8]

On the other hand, plaintiff contends that sometime between October 12 and October 22 Foster conceived that

5. Transcript of Argument—October 25, 1962—p. 28.

6. Transcript of Argument—October 25, 1962—p. 23.

7. Whether the bread board model was operative for its intended purpose is immaterial. Admitted, it was not a desirable commercial arrangement.

8. Defendant's alternative contention that Farber was a joint inventor with Foster is outside of the issues defined by the pretrial order. See footnote 2.

a unitary assembly fixing the probe in a rigid relationship with the electrical contacts and adjusting screw was essential to a satisfactory operation of the thermostat and that Farber and Foster disclosed this to Comee and Moorhead when they visited plaintiff's plant on October 22. Plaintiff asserts further that the use of the bracket involved no inventive skill by defendant's employees since the use of the bracket was the usual and normal way to make a unitary thermostatic assembly, and that Foster and Farber had told Moorhead and Comee that such a unitary assembly was necessary. Because of this, plaintiff argues that although the model which defendant built was the first reduction to practice of the invention, it was in legal contemplation a reduction to practice by Foster, since defendant's employees were just "another pair of hands" working for Foster.

On these key issues the evidence is not too satisfactory. On balance, however, it supports a finding that Foster recognized, after his cooking experiment on October 14, 1954 and before he met with Comee and Moorhead on October 22, 1954, that it was necessary for the probe, electrical contacts and adjusting screw to be kept in rigid alignment by means of a unitary assembly in order to obtain accurate calibration, to permit the requisite amount of play of the thermostat in the plug, and to enable the thermal unit to be shipped satisfactorily for assembly in the plug by Leviton. This finding is based upon the testimony of Foster and Farber as to discussions which they had with each other between October 14 and October 22. It is not corroborated by any other witness or by documentary evidence of any kind. While such testimony is, as a rule, somewhat suspect, I find no reason to reject it in this case.

Despite Foster's conception, his invention was not complete until he had reduced it to practice. This is a settled principle of patent law. Hann v. Venetian Blind

Corp., 111 F. 2d 455, 458 (9 Cir. 1940); Consolidated Vultee Aircraft Corp. v. Maurice A. Garbell, Inc., 204 F. 2d 946, 949 (9 Cir. 1953), cert. den. 346 U. S. 873, 74 S. Ct. 122, 98 L. Ed. 381 (1953); Corona Cord Tire Co. v. Dovan Chem. Corp., 276 U. S. 358, 383, 48 S. Ct. 380, 72 L. Ed. 610 (1928). A machine is reduced to practice when it is assembled, adjusted and used. E. I. DuPont De Nemours & Co. v. American Cyanamid Co., 120 F. Supp. 697, 701 (D. D. C. 1954); Corona Cord Tire Co. v. Dovan Chem. Corp., supra. To establish reduction to practice of an invention for a mechanical device, the device tested must include all of the elements of the claim in issue. Akers v. Papst, 113 F. 2d 136, 139, 27 CCPA 1400 (1940); Greene v. Beidler, 58 F. 2d 207, 208 (2 Cir. 1932). Compare Daniels v. Permutit Co., 137 F. 2d 823 (3 Cir. 1943). The model constructed by defendant's employees and exhibited to Foster and Farber on December 2, 1954 constituted the first reduction to practice of the invention asserted in Claim 1. The question is therefore whether this was in legal contemplation a reduction to practice by defendant's employees in their own right, or as "another pair of hands" for Foster.

On October 22, Farber and Foster had their first meeting with representatives of the defendant following Foster's initial meeting with Burch on October 12. Four persons were present: Foster, Farber, Burch and Comee. The net of the testimony of Foster and Farber is that they told Burch and Comee that it would be necessary to construct the thermostat so that the contacts, probe and adjusting screw would be supported as a unit. On the other hand, Burch testified that there was little discussion at the time. When asked whether he received any advice as "how to produce a * * *", he interrupted the question and answered, "Absolutely none, this is a positive statement." However, he testified that he understood from Foster and Farber that plaintiff wanted defendant to manufacture a

"complete thermostat," and that a "complete thermostat" would have to "include the bracket and contacts".

At the meeting on November 11, while various business phases of the transaction were being discussed by Farber and Ottmar, Foster had technical discussions with Comee. Foster testified that he told Comee of the manufacturing requirements, and that he pointed out again that the thermostat and contacts would have to be a complete unit so there would be a rigid mounting of the contacts and the probe to eliminate unwanted motion.

At the time when Moorhead built the model which he exhibited to Foster and Farber on November 17, he had not talked to anyone in plaintiff's organization. When he was asked who designed and put the bracket into the model, he testified, "That was my idea". Moorhead said that the information which he used in making the thermostat was obtained from Comee and possibly from Burch, and that, "I remember most of my information came from our representatives that brought the information back from Farber." Moorhead made no claim to have improved upon the device which he had been instructed to build.

Defendant relies heavily upon Foster's deposition to establish that defendant's employees were the first to conceive of the use of the bracket to join the probe, contacts and adjusting screw. In his deposition Foster testified that the bracket and the affixation of the bracket to the contact members was a contribution of Burch and the Metals & Controls people. Foster said that his contribution went back to the original idea of a probe type thermostat in a frying pan and that the details were someone else's. Shortly before this testimony had been elicited, Foster had been asked whether he or Spencer or Burch had developed the "mechanical details" of the thermostat, to which Foster replied that he assumed that Burch had. The testimony which followed this inquiry, and upon which

defendant relies so heavily, could well have been understood by Foster as referring to the "mechanical details" about which he had just been interrogated. When Foster was examined by plaintiff at the trial on the subject of his deposition, he said he considered that the deposition questions had related to the actual physical parts of the thermostat. All things considered, this explanation seems reasonable enough.

There is no proof that either Foster or Farber told defendant's employees that in manufacturing the thermal element they should utilize a bracket to keep the contacts and probe in alignment. Defendant's representatives were told, however, that a unitary assembly of the probe and contacts was essential. The normal and usual way in which to construct the unitary assembly was by means of a bracket. Dr. Fischer, defendant's expert, admitted that it would take considerable thought on his part to make a unitary assembly in any other way. Under the circumstances, the specific design contribution by defendant's employees—the bracket to effect a unitary assembly—did not rise to the height of an inventive contribution. In the light of the instructions they received from Foster, the use of the bracket was a mechanical detail of an obvious kind which any qualified engineer or designer could reasonably be expected to make. This was not enough to establish a joint invention. Alto Company v. Fish Manufacturing Co., 158 F. Supp. 752, 755 (D. N. J. 1957), aff'd per curiam 252 F. 2d 299 (3 Cir. 1958); Adams v. Columbus Mfg. Co., 180 F. Supp. 921, 929 (M. D. Ga. 1960); 1 Walker, Patents (Dellers' Ed. 1937) 403.

It has been said that one may be a joint inventor, even though the conception of the entire device may be due to another, if he makes suggestions of a practical value which assist in making the main idea operative, or contributes an independent part of the entire invention which is united with the parts produced by the other and creates the whole.

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corporation, 72 F. 2d 53, 56 (3 Cir. 1934), rev. on other grounds, 294 U. S. 477, 55 S. Ct. 455, 79 L. Ed. 1005 (1935). This principle is without application to the case at bar, since no suggestions of practical value were made by employees of defendant save those which were obvious under the instructions which Foster and Farber gave to them.

Cases such as Q-Tips, Inc. v. Johnson & Johnson, 207 F. 2d 509, 511 (3 Cir. 1953), cert. den. 347 U. S. 935, 74 S. Ct. 630, 98 L. Ed. 1086 (1954), which hold that in a suit for the infringement of the combination patent, every element claimed is deemed essential and the patentee will not be heard to assert its immateriality, are without relevance here. Plaintiff does not disavow the importance of the bracket to the satisfactory operation of the thermal unit. Its importance is conceded. Plaintiff simply asserts Foster and Farbar explained to defendant's employees the necessity for a unitary assembly of the probe and contacts and that the use of a bracket was the normal and obvious way to make it.

Working as they did under instructions which they had received from Foster and Farber in an effort to produce a thermostat which would be satisfactory to plaintiff, defendant's employees were simply "another pair of hands" for Foster. It is not material that plaintiff made no payment to defendant for its development work and that the price of the thermostat did not include as a factor the development costs of defendant.

It follows that neither Burch nor defendant's employees, Moorhead or Butts, was a joint inventor with Foster of the subject matter of Claim 1.

This opinion constitutes the findings of fact and conclusions of law required by F. R. Civ. P. 52(a).

December 5, 1962
Wilmington, Delaware

Appendix B

Decision—Second Trial

IN THE

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

Civil Action No. 2271

STEEL, J:

S. W. Farber, Inc., the plaintiff, sued Texas Instruments Incorporated, the defendant, for infringement of United States Letters Patent No. 2,926,230 issued to plaintiff as assignee of Hoyt K. Foster, the patent applicant. The patent states that it pertains to an improved detachable electrical connector and temperature regulator for electrically controlled heating devices. Defendant has denied validity but admitted infringement if the patent is valid. The thermostatic control plugs which defendant has manufactured and sold to West Bend Company, Mirro Aluminum Company and McGraw Electric Company are illustrative of the accused devices.

Defendant has filed two counterclaims. The first seeks a declaratory judgment adjudging the patent to be invalid, or alternatively, that the invention claimed was made in whole or in part by persons associated with defendant or its predecessor. The latter issue was tried separately and determined adversely to defendant. *S. W. Farber, Inc.* v. *Texas Instruments Incorporated,* 211 F. Supp. 686 (D. Del. 1962).[1] The second counterclaim is for unfair competition.

Much of the background of the controversy is disclosed in the opinion at 211 F. Supp. 686 and the Findings of

1. Defendant has reserved the right to appeal from this decision.

Fact and Conclusions of Law stated there are incorporated herein by reference. By stipulation the record in the earlier trial is part of the present record.

JURISDICTION

The complaint seeks relief under the patent laws and jurisdiction exists under 28 *U. S. C.* §1338(a). Counterclaim 1 arises out of an actual controversy between the parties as to the charge of infringement made by plaintiff against defendant and defendant's contention that it has rights to the patent in suit which plaintiff denies. Jurisdiction of counterclaim 1 exists under 28 *U. S. C.* §§2201-2202. Counterclaim 2 alleges a claim for unfair competition which has been joined with a substantial and related claim under the patent laws. Jurisdiction over counterclaim 2 exists under 28 *U. S. C.* §1338(b).

THE VALIDITY ISSUE

The parties have agreed that claims 2 and 4 are typical or representative, that if claims 2 and 4 are valid, all claims are valid; if claims 2 and 4 are invalid, all claims are invalid, and if either claim 2 or 4 is valid and the other invalid, the remaining claims are not adjudicated.

While a number of defenses have been pleaded, only that asserted under 35 *U. S. C.* §103 need be dealt with.[2] It provides that although an alleged invention is not identically disclosed or described in the prior art specified in Section 102 of Title 35, a patent may not be obtained if

2. Defendant sought leave to plead the defenses of unclean hands, patent misuse and anti-trust violation. Leave was denied because their assertion was not timely.

the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention to a person having ordinary skill in the art.

In early 1954 two thermostatically controlled fry pans were put on the market. One was manufactured by Sunbeam and the other by Presto. The Presto pan could not be immersed in water for washing. That manufactured by Sunbeam could be immersed only up to the temperature dial on the handle and carried a notice to that effect. It had the thermostat permanently secured in the handle, and it could not be detached.

Sometime in 1954 Foster, the chief engineer of the plaintiff, recognized the desirability of developing an electrically heated, thermostatically-controlled fry pan which could be completely immersed for washing without damaging the pan. This was not possible with any of the electrified fry pans then being marketed.

With complete immersibility as his goal, Foster, prior to October 12, 1954, conceived the general idea of putting a probe type of thermostat in an electric plug which could be detached from the pan when it was washed. Under this general concept a portion of the probe would extend from the plug through a hole midway between the receptacle contacts of the plug and enter a recess in the bottom of the pan so as to engage the bottom of the pan and sense its temperature when the plug and pan were in operational relationship. It was Foster's idea that when the electric current heated the pan above the desired temperature the thermostat would open the circuit, and when the temperature of the pan fell below the desired temperature the thermostat would close the circuit, thus enabling the heat of the pan to be maintained at a relatively uniform predetermined temperature.

Appendix B — Decision—Second Trial

On November 30, 1954 Foster filed a patent application, Serial No. 471,949, embodying this concept. It eventuated in patent No. 3,095,498. The 498 patent is not in suit, for it did not issue until June 25, 1963 after the present action was begun. The 498 patent is for a combination consisting of an electrical cooking utensil and a detachable thermostat housed in an electrical plug. This initial concept did not embrace the use of any particular kind of probe thermostat, although there were several types on the market. The specifications provided that the thermostat could be

> "operated in any conventional manner such as by means of a bi-metal element or an expansible fluid and bellows and is preferably of the "on-off" type with the adjustment of the device being effected by means of a knob * * *".

As stated, the 230 patent relates to an "improved" detachable electrical connector and temperature regulator for electrically controlled heating devices, such as a cooking utensil. Unlike the 498 patent, the 230 patent does not claim the device with which the connector is to be used. The 230 patent is merely for a specific type of probe thermostat consisting of a combination of elements housed in an electrical plug. It is intended for use as a substitute for the unspecified type of probe thermostat disclosed in the 498 patent.

The subject matter disclosed and claimed in the 230 patent was conceived by Foster sometime after his cooking experiment on October 14, 1954 and before October 22, 1954. It was reduced to practice on December 2, 1954. On that date the invention of the 230 patent was complete. *S. W. Farber, Inc.* v. *Texas Instruments Incorporated, supra,* p. 692. Foster filed his original application, Serial No. 535,797, on September 22, 1955, and this eventuated in the 230 patent on February 23, 1960.

Originally, Foster had in mind using a probe thermostat of the bulb and bellows type in his control plug.[3] Later, he began looking for a probe thermostat of the cartridge type. There were several of these on the market.[4] The first time that Foster saw one which was sufficiently small to be adapted to a removable plug for use with a fry pan was on October 12, 1954 when Lyndon W. Burch visited plaintiff's plant and showed Foster a cartridge thermostat embodying a "rod and tube" thermal element which Burch had developed.

The 230 patent carried forward Foster's original idea disclosed in the 498 patent, by substituting a unitary thermostatic switch embodying the thermal element which Burch showed Foster on October 12, 1954 in place of the schematic generalized showing of a thermostat found in the 498 patent.

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3. A bulb and bellows thermostat consists of a bulb, a pair of bellows, and a thin tube which connects the bulb and bellows. The bulb and bellows are usually metallic. What the tube is made of is not disclosed. The bulb, tube and bellows are airtight and contain a gas of some type. The bulb is immersed in or placed in contact with the material the temperature of which is to be controlled. When the material is heated the gas expands, and when the material cools the gas contracts. This expansion and contraction causes an increase or decrease in pressure which is transmitted through the tube to the bellows which are thereby caused to open and close. The end of the bellows outside of the tube are attached to an electrical contact. When the bellows open, the circuit is broken; when the bellows close, the circuit is closed. In this way the heat which is electrically generated can be maintained at a pre-determined temperature.

4. One type of cartridge thermostat is composed of a piece of hollow tubing closed at one end. Enclosed within the tubing is a bi-metallic thermal element consisting of two flat strips of different metals bonded to each other, which expand at different rates upon being subjected to heat. One end of the bi-metallic element is mounted within the tube. The other end extends out of the open end of the tube and is connected to an electrical contact. Upon the application of heat to the tube one strip in the thermal element expands at

The thermal element disclosed by the 230 patent was the subject of an application, Serial No. 420,064 which Burch had filed on March 31, 1954. This eventuated in patent No. 2,793,270 which issued to Burch on May 21, 1957.

The critical question under 35 *U. S. C.* §103 is not whether the alleged invention in the 230 patent is identically disclosed or described in the prior art specified in 35 *U. S. C.* §102. The issue is whether the differences between the subject matter of the 230 patent and the §102 prior art are such that the subject matter of the 230 patent as a whole would have been obvious on December 22, 1954 to anyone having ordinary skill in the art to which its subject matter pertains.

When Foster faced the problem of developing a detachable temperature regulating connector to be used with

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greater rate than the other. This effect causes a mechanical bending of the bi-metal element, thereby creating lateral movement at the end of the element affixed to the electrical contact. This movement opens the contact. Conversely, when the heat is removed the metals contract at different rates causing an unbending, lateral movement in the opposite direction of the bi-metal element and a closing of the contact.

Another kind of cartridge thermostat is the "rod and tube" type. This consists of a hollow tube closed at one end. The tube is made of a high expansion metal. A rod inside the tube is of low expansion metal and one end thereof is fastened in the tube to the closed end of the tube. The other end of the rod is fastened to a flexible narrow extension of the wall of the tube at its open end. When heat is applied to the cartridge the tube expands longitudinally at a greater rate than the rod, thereby casting the flexible extension on the tube to be pulled toward the center of the tube. The extension is fastened to an electrical contact which is caused to be opened by the movement of the extension. When the heat is removed the tube contracts at a greater rate than the rod and the extension is pushed in the opposite direction, closing the contact. Thermostats employing the bi-metal principal were used for breaking electrical circuits long before 1941 for a wide variety of electrical devices such as flat irons, coffee cookers, bread toasters, etc. *Cuno Engineering Corp.* v. *Automatic Corp.*, 314 U. S. 84, 88 (1941).

electrically heated devices, he was chargeable with knowledge of the following prior art patents: Gaunt British patent No. 599,224 for which complete specification was accepted on March 8, 1948, Ross United States patent No. 1,431,542, which issued on October 10, 1922, Norton U. S. patent No. 2,024,471 which issued on December 17 1935.[5]

Each of these three patents disclosed, as does the 230 patent, a detachable temperature controlling connector unit for an electrically heated device having spaced terminals, the connector unit comprising in combination a housing and a pair of spaced terminals for cooperating with the terminals of the device to be heated for applying electrical energy thereto. Each of the three patents contains a thermostat of some type.

Claim 2 of the 230 patent reads:

> "*A detachable temperature controlling connector unit for an electrically heated device, having space*[*d*] *terminals, said connector unit comprising in combination a housing, a pair of space*[*d*] *terminals for cooperating with the said first terminals for applying electrical energy thereto,* a support mounted within said housing and carrying a tubular member extending outwardly from said housing in relation to the terminals thereof, said tubular member being adapted to be positioned in heat transfer relation with the said device when its said terminals are positioned in cooperation with the first terminals on said device, a pair of resilient contact carrying members on said support and connected to control the application of energy to said terminals, adjustable means for fixing the position of one of said contact carrying members, and means within said

5. The question of whether British patent No. 725,341 or Belgian patent No. 518,320 were in the prior art on December 12, 1954 need not be decided.

tubular member having its inner end in engagement with the distal end of the tubular member, the outer end of the last said means coupled in motion amplifying relationship to the other of said contact carrying members to actuate the contact carrying members in response to temperature changes sensed by said tubular member, the temperature at which said actuation of the contact carrying members takes place being determined by the position of one contact carrying member."[6]

Kelley, who testified as an expert for plaintiff, identified the underscored [italicized] portions of claim 2 as described in the Ross Patent No. 1,431,542.

Claim 4 of the 230 patent reads:

"*A detachable temperature regulating and power-supplying connector for an electrically heated device, comprising in combination an elongated hollow housing, having an end-wall part, including at least three spaced openings, a pair of terminals in said housing aligned with two of said openings,* a metallic bracket within said housing, an elongated hollow metallic probe fixedly secured to said bracket and extending through the third of said openings and from the housing, a pair of cooperating contacts within said housing, and affixed in insulating relationship to said bracket, an elongated member within said probe with one end of said member engaging the distal end of said probe, and the other end of said member in coupled, motion amplified relationship with said contacts to open and close them in accordance with changes in temperature of said probe, a power supply cable attached to said hous-

6. Underscoring supplied unless otherwise indicated. [The words underscored by the Court are indicated in this Record by italics.]

ing and connected to one of said housing terminals and one of said contacts and a connection between the other of said contacts and the other of said housing terminals."

Kelley stated that the underscored portion of claim 4 described the disclosure of the Ross Patent No. 1,431,542.

The underscored portions of claims 2 and 4 make no reference to a thermostat. The language of the claims which is not underscored describes the thermostatic element of the claims. Obviously, it is not the thermostat which Ross disclosed.[7] The language which is not underscored does, however, describe the "rod and tube" thermal actuator of the then pending Burch patent application, plus a bracket (mounted in the plug) which connects the thermal actuator with a pair of resilient contact carrying members and a screw to adjust the position of one of the members.

Prior to December 2, 1954, when Foster completed his invention, the Burch thermal actuator disclosed in Burch's application filed on March 31, 1954, was part of the prior art, since Burch's application antedated Foster's, and Burch's patent was issued prior to Foster's 230 patent. *Detrola Corp.* v. *Hazeltine Corp.*, 313 U. S. 259, 265, 269 (1940).[8] In addition, Burch had actually exhibited his thermal actuator to Foster on October 12, 1954. This was not done in a confidence, nor with the exaction of pledges of secrecy from Foster.

7. The Ross patent disclosed a metallic thermostat composed of two thin strips of metal having different coefficients of expansion connected to a metallic conducting pin designed to project outwardly through the middle hole of the connector and to abut against, or enter a suitable recess in the utensil, the heat of which was to be controlled.

8. Although this decision antedated the 1952 Patent Act, the same rule has been applied under the 1952 Act. *Hazeltine Research, Inc.* v. *Ladd*, 226 F. Supp. 459 (D. C. D. C. 1964).

There was nothing inventive about using the Burch thermal actuator to thermostatically control the opening and closing of an electric circuit. Prior to October 12, 1954, Burch had shown a thermostat using his thermal actuator to a manufacturer's representative in Connecticut, and a thermostat employing the Burch actuator had been used commercially on an aircraft ground heater. Indeed, when Burch met with Foster on October 12, he showed him a thermostat (DX 29) which employed his thermal actuator, although it was not in an electrical plug.[8-a] So that a thermostat which embodied the Burch actuator was also in the prior art before October 12, 1954.

To give the Burch thermal element the utility which Foster disclosed in the 230 patent, it was necessary to do two things: first, connect the probe, switch contacts, and a screw for adjusting the contacts by a metallic bracket so as to hold the three elements together rigidly as a unit, and second, install the assembly (probe, contacts, and adjusting screw so connected) in an electric plug having two electrical receptacles with a hole between through which the probe extended to perform its heat sensing function when in contact with the bottom of the fry pan.

The physical accomplishment of these two steps was carried out by employees and associates of the defendant working as "another pair of hands" for Foster and under his direction. See *S. W. Farber, Inc.* v. *Texas Instruments, Incorporated, supra,* 693. The use of a bracket to render the assembly unitary so that the probe, contacts and adjusting screw were joined together in a fixed and rigid relationship with each other, was not inventive. It was simply the mechanical way to accomplish the desired result and would have been readily perceptible to any worker skilled in the field who was told to combine the three ele-

8-a. Whether Burch also showed Foster DX 44 and 46 need not be determined.

ments into a single rigid assembly. *S. W. Farber, Inc.* v. *Texas Instruments Incorporated, supra,* p. 693. Nor did the general idea that the assembly would have to be unitary, which Foster imparted to the employees and associates of defendant, rise to the height of invention. If the thermostat were to have accurate calibration, the amount of wiggle or play in the plug required because of the expansion and contraction of the fry pan when in contact with the probe, and be in condition to be shipped to the Leviton Manufacturing Company (as was planned) for installation in the plug, it was necessary for the probe, contacts, and adjusting screw to be held together rigidly as a unit. This would have been obvious to anyone having ordinary skill in the art. The concept of installing the thermostat in the plug was not inventive, for that idea was revealed not only in Ross but also in the Gaunt British Patent No. 599,224 and Norton U. S. Patent No. 2,024,471.

Kelley pointed to many deficiencies in the Ross patent which he said made the operation of its structure impractical. The "most glaring ones" he said, were the shock hazards and possibility of short circuits. Kelley acknowledged, however, that these deficiencies would be recognized by a person skilled in the art and could be readily corrected. Kelley also pointed out that the erratic ambient temperature variations inherent in the Ross structure would cause it to operate unsatisfactorily. But this defect, and others which Kelley emphasized to a lesser degree, could all be remedied by substituting the Burch thermal probe in unitary assembly with the contact switches and adjusting screw, for the metallic conducting pin and thermostatic arrangement disclosed by Ross.

Defendant* argues that it is not permissible for an infringer to go to the prior art and defeat a patent by select-

* Should be Plaintiff.

ing various elements thereof and bringing them together and saying that the aggregation anticipates invention of the patent. *Atlantic Refining Co.* v. *James B. Berry Sons Co.*, 106 F. 2d 644, 650 (3rd Cir. 1938) so holds. But here the defense under examination is not anticipation dealt with by §102; the defense is obviousness under §103.

Plaintiff concedes that all of the structural elements found in claims 2 and 4 of the 230 patent were known before Foster conceived of his alleged invention. The conjunction or concert of known elements must contribute something. Only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. This is established doctrine. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 152 (1950). There, a patent consisting of a combination of mechanical elements was held to be invalid because the combination had not resulted "in any unusual or surprising consequences," 340 U. S. at 152. The same thing is true of the combination of elements disclosed in claims 2 and 4 of the 230 patent. The Burch thermal element works in precisely the same manner regardless of whether it is in or out of the structure of the 230 patent. It would also work in the same way if it were in the Ross patent.

It may be conceded that the function performed by the structure disclosed in the 230 patent was "new and useful". This, however, is not enough to make it patentable. Under 35 *U. S. C.* §101 "invention" or "discovery" is a prerequisite to patentability. See *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 90 (1941) decided under 35 *U. S. C.* §31; *R. S.* §4886, the forerunner of §101 of 35 *U. S. C.* In *Chemical Construction Corp.* v. *Jones & Laughlin Steel Corporation*, 311 F. 2d 367, 371 (3rd Cir. 1962), the Court stated that the *Great Atlantic & Pacific Tea Co.*, *Cuno Engineering Corporation*, and other Supreme Court cases had established a "high standard" of inventiveness

which was required to warrant the issuance of a patent. Claims 2 and 4 fail to meet that standard.

Plaintiff points out that both the Ross and Burch patents were cited in the Patent Office against the 230 patent but nevertheless the subject matter of 230 was held to be patentable. Admittedly, this enhances the presumption of validity which arose when the patent issued. *Hartford National Bank & Trust Co.* v. *E. F. Drew & Co., Inc.*, 133 F. Supp. 648, 652 (D. Del. 1955), aff'd. 237 F. 2d 594 (3rd Cir. 1956). But this circumstance is not of controlling significance. The standard of inventiveness employed by the patent office is far below that applied by the courts. *Picard* v. *United Aircraft Corporation*, 128 F. 2d 632, 641 (2nd Cir. 1942), cert. den., 317 U. S. 651 (1942). The category of patented unpatentables has been held to be large. *Packwood* v. *Briggs & Stratton Corp.*, 195 F. 2d 971, 974 (3rd Cir. 1952), cert. den. 344 U. S. 844 (1952).

Plaintiff likewise stresses the fact that the structure disclosed and claimed by Foster has come into widespread use, been adapted by industry, and achieved commercial success. Commercial success, however, without invention will not make patentability. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra*, p. 153.

In view of the Ross patent and the Burch thermal switch, the difference between claims 2 and 4 of Foster's 230 patent and the prior art on December 2, 1954 were such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter of the patent 230 pertains. Invention is lacking. Patent 230 is, therefore, invalid, and the complaint will be dismissed. A declaratory judgment will be entered under Counterclaim 1 adjudging the 230 patent to be invalid.

UNFAIR COMPETITION

Defendant's counterclaim for unfair competition is based upon the contention that plaintiff (i) advertised its plug as patented almost five years before the 230 patent issued, (ii) obtained a patent for a device which was not patentable, and (iii) threatened customers of defendant with infringement suits so as to make it necessary for the defendant to indemnify them.

Preliminarily, a word should be said about the law to be applied. The unfair competition claims have their source in state law and would appear to require the application of state law even though they arise in litigation involving a claim of patent infringement based upon federal law. *C.f., Maternally Yours* v. *Your Maternity Shop,* 234 F. 2d 538, 540-541, N. 1 (2nd Cir. 1956); *Blisscraft* v. *United Plastics Company,* 294 F. 2d 694, 697 (2nd Cir. 1961). Although there is evidence where some of the alleged acts of unfair competition took place, such as the states in which defendant's customers were threatened with infringement suits by plaintiff, neither of the parties has raised any question about whether federal or state law should be applied or has asserted that the application of the law of one state as against that of another brings about a different result. Under the circumstances, reliance upon the "indeterminate general law" is warranted. *Maternally Yours* v. *Your Maternity Shop, supra,* p. 540, N. 1; *American Safety Table Co.* v. *Schreiber,* 269 F. 2d 255, 271 (2nd Cir.), cert. den. 361 U. S. 915 (1959).

It is conceded that plaintiff distributed a circular to dealers in October of 1955 which depicted its "automatic electric fry pan" and said:

Appendix B — Decision—Second Trial

"EXCLUSIVE! *Thermostatic Control*
IN THE PLUG!

> This new amazing, patented Farberware feature means you can *completely* immerse the fry pan in water for safer, easier, quicker cleaning.'"[9]

About 40,000 of these circulars were printed, although the precise number which plaintiff distributed is not disclosed.

The claim that the Foster plug was patented was, of course, untrue inasmuch as the 230 patent did not issue until February 23, 1960. An announcement that a device is protected by a patent when in fact it is not does not amount to unfair competition unless the announcement was intentional. *Deering, Milliken & Co.* v. *Temp-Resisto Corporation,* 160 F. Supp. 463, 485 fn. 11 (S. D. N. Y. 1958); mod. on other grounds, 274 F. 2d 626 (2nd Cir. 1960).

Circulars distributed in late 1955 or early 1956 made no claim that the plugs were patented. None of the booklets which accompanied the appliances distributed from 1955 on indicated that the plugs were protected by patents. The control plugs which plaintiff sold in 1955 and 1956 were marked, quite properly, "patent pending." An advertisement by plaintiff in *Life* in the spring of 1956 as well as a reproduction thereof which plaintiff supplied to its dealers for display with its merchandise, likewise stated that a patent was pending on the control plug. Plaintiff was not aware of its erroneous claim that its plug was patented until defendant called it to plaintiff's attention when Foster's deposition was taken on December 2, 1960. From this combination of circumstances, it is clear that the claim

9. Emphasis appears in the circular.

that the plug was patented, which plaintiff made in a single batch of circulars distributed in October 1955, was inadvertent and not occasioned by any deliberate intention to gain an unfair advantage over defendant or other competitors.

Within a month after the 230 patent issued, plaintiff wrote certain of its competitors and charged that devices which they were selling infringed plaintiff's patent rights. This was not an unfair competitive practice. The patent, having issued, was presumptively valid. 35 *U. S. C.* §282. The very purpose of the patent was to enable plaintiff to prevent non-permissive use of structures covered by it. The notices which plaintiff sent were in furtherance of this purpose.

It is not significant that plaintiff threatened to sue customers of the defendant for infringement and that this compelled defendant to indemnify its customers against damages they might sustain as a result of such actions. At the time, the patent was presumptively valid. There is no evidence that plaintiff's infringement notices were sent in bad faith for the sole purpose of destroying the defendant's business. In the absence of such proof the giving of the infringement notices was not wrongful. *A. B. Farquhar Co.* v. *National Harrow Co.*, 102 Fed. 714, 715 (3rd Cir. 1900); *Cheney Co.* v. *Cunningham*, 37 F. Supp. 224, 230 (W. D. Pa. 1941); aff'd 127 F. 2d 294 (3rd Cir. 1942).

Counterclaim 2 based upon plaintiff's alleged unfair competition will be dismissed.

The case is not such an exceptional one as to justify an award of attorneys fees to the defendant under 35 *U. S. C.* §285.

Wilmington, Delaware
May 8, 1964

Appendix C

Judgment Appealed to the Third Circuit Court of Appeals

IN THE

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

This action came on for trial before the Court, Honorable Edwin D. Steel, District Judge, presiding, and the issues having been duly tried and a decision having been duly rendered.

IT IS ORDERED AND ADJUDGED:

That the Plaintiff take nothing, and that the action be dismissed on the merits.

That Counterclaim 1, based upon the alleged invalidity of the Foster patent, be granted to the extent that United States Letters Patent No. 2,926,230 issued to Plaintiff as assignee of Hoyt K. Foster be adjudged invalid and void and of no force and effect.

That Counterclaim 2 based upon Plaintiff's alleged unfair competition be dismissed on the merits, and that Defendant, Texas Instruments Incorporated, take nothing thereon.

That the costs incident to the main action and to the counterclaim seeking declaratory relief adjudging Letters Patent No. 2,926,230 to be invalid, be taxed against Plaintiff; the costs incident to the counterclaim seeking relief based upon Plaintiff's alleged acts of unfair competition be taxed against defendant; and that the amount of the cost to be taxed against each party be determined by the Clerk upon the application of either party.

Appendix C

Judgment Appealed to the Third Circuit of Appeals

That the opinion herein constitutes the findings of fact and conclusions of law herein.

Dated at Wilmington, Delaware, this 12th day of June, 1964.

/s/ Edwin D. Steel, Jr.
D. J.

Appendix D

Opinion of the Court

(Filed April 20, 1965)

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT

PER CURIAM:

This patent infringement suit, tried to a district judge sitting without a jury, resulted in a judgment on the merits for the defendant. The court found that the claimed invention consisted of mechanical improvements and adaptations of the prior art which would have been obvious at the time in question to a person of ordinary skill in the art. Accordingly, applying the test stated in section 103 of Title 35, U. S. C., the court held that the differences between the subject matter sought to be patented and the prior art were not patentable.

The finding of obviousness is supported by affirmative testimony and cannot be characterized as unreasonable or unwarranted in the light of a record which discloses fully and with particularity the simple mechanical adaptations of familiar structures, directly indicated by the problem to be solved, which are the essence of the claimed invention.

The judgment will be affirmed on the proper findings and the logical and convincing analysis of the district court. 1964, 230 F. Supp. 883.

A True Copy:

Teste:

Clerk of the United States Court of Appeals for the Third Circuit.

Appendix E

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT

ON APPEAL FROM

THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

Present:

HASTIE and FREEDMAN, *Circuit Judges,*
and WEBER, *District Judge.*

JUDGMENT

This cause came on to be heard on the record from the United States District Court for the District of Delaware and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court filed June 12, 1964, in this case be, and the same is hereby affirmed, with costs.

Attest:

IDA O. CRESKOFF
Clerk

April 20, 1965

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MAR 13 1965
JOHN F. DAVIS, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 354

S. W. FARBER, INC., *Petitioner,*

v.

TEXAS INSTRUMENTS INCORPORATED, *Respondent.*

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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IN THE

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

STATEMENT

The statement of Petitioner is insufficient to give this Court a true picture of the background and circumstances as to the patent in suit and the question presented. Thus, Respondent must amplify Petitioner's statement to some extent.

Petitioner is the owner of two patents relating to electrically heated apparatus with detachable probe type thermostats. One of these is Patent No. 3,095,498 (hereinafter referred to as '498 patent) and the other

is Patent No. 2,926,230 (Defendant's Exhibit 1, Appellant's Appendix following page 158a, hereinafter referred to as '230 patent). The '498 patent embodies what the alleged inventor himself considered his invention to be, namely, that of an electrically heated apparatus such as a frypan in combination with a detachable probe type thermostat. The application for the '498 patent was filed in the U. S. Patent Office on November 30, 1954, but described and claimed no specific form of probe type thermostat for the detachable control plug. However, the specific rod and tube type thermostat of the '230 patent in suit was known to Petitioner at the time the application for the '498 patent was filed. Subsequently, on September 22, 1955, Petitioner filed a patent application directed intentionally to the rod and tube type thermostat now in suit (provided by Respondent or its licensor) and the application eventually became the '230 patent in suit. Petitioner has steadfastly avoided bringing the '498 patent into the suit although the subject matter thereof has been ever present.

The statement has been made in the paragraph above that the alleged inventor and patentee, himself, considered his invention to be that of the combination of an electrically heated apparatus and a detachable probe type thermostat, the '498 patent subject matter, and not the specific rod and tube type thermostat subsequently embodied in the '230 patent in suit. The basis therefor is that Lyndon W. Burch brought to the alleged inventor, Hoyt K. Foster, on October 12, 1954, several complete and working rod and tube type thermostats, demonstrated their operation to him and explained their construction in detail. The alleged inventor thereafter copied one of the thermostat

models into an appropriate electrical connector from one day to the next, tested his model and found it suitable for his purposes. The embodiment thus fashioned by the alleged inventor merely duplicated the work of Lyndon W. Burch in detachable thermostat control plugs well known in the art such as shown by Ross patent 1,431,542, Norton patent 2,024,471 and Gaunt British patent 599,224 (Petitioner's Appendix 40).

For support and verification of the above, portions of the deposition of the alleged inventor himself are quoted below (Appellee's Appendix, pp. 1b et seq.):

> Q. If we can, let's place the events that led up to your use of the rod and tube thermostat, and I think the easiest way is for you to tell me exactly how it happened that you came to the rod and tube thermostat. A. Starting some time in the early summer, or maybe a little before the early summer, of '54, I started asking every representative of a thermostat company that called on us if they made or if they knew anybody that made a cartridge type thermostat. In other words—
>
> Q. Maybe it would be a good idea to define cartridge type. A. I was referring to a cartridge type thermostat which would be used as a probe, not necessarily rod and tube. Then, when making this inquiry of a friend in Massachusetts, he told me that he had seen recently a cartridge type thermostat that he thought might be what I was looking for. It was shown to him by a distributor that I can't tell you the name of any more, in Hamden, Connecticut.
>
> * * * * *
>
> He showed me—rather, he told me—that the man who had this thermostat was Lynn Burch, and a few days after that, Lynn called me before I had a chance to get in touch with him. He then came